

REMARKS

Claims 1-9, 11-38, 40, 50, 55, 60, and 80-87 are pending. Claim 55 is withdrawn from consideration. Claims 1, 6, 23, 31, 38 and 60 have been amended herein. Claim 50 is allowable. No new matter has been added with the Amendments, being fully supported by the specification and claims as originally filed. Upon entry of this communication, claims 1-9, 11-38, 40, 50, 60, and 80-87 will be under consideration.

The Advisory Action mailed January 6, 2005 indicates that the proposed amendments to the claims filed December 13, 2005 will not be entered because: 1) they raise new issues that require further consideration; 2) they raise issues of new matter; and 3) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Applicants respectfully maintain that the proposed amendments do not raise new issues or issues of new matter. Further, the proposed amendments to the claims not only place the claims in better condition for appeal, they in fact place the claims in condition for allowance.

Specifically, the Office action states that the proposed amendment to claim 6, which recites a ubiquitin homolog having an amino acid sequence that is "at least 85% identical to the amino acid sequence of wild-type ubiquitin" raises a) new matter and b) new issues requiring a further search. With regard to the suggestion that the proposed amendment raises new matter, Applicants point to page 13, lines 9-19 and to lines 29-31, which clearly provide support for destabilization domains comprising a ubiquitin homolog having 85% homology to wild-type ubiquitin. In view of the information provided in the specification, the proposed amendment does not constitute new matter.

In addition, Applicants note that the proposed amendment to claim 6 was made in response to the Examiners statement that:

"the specification has not adequately described the structure of the ubiquitin homologs encompassed by the claims – the disclosure does not indicate any structure-function relationship such that one of skill in the art would recognize the ubiquitin homologs encompassed by the claims" (see Final Office Action dated August 13, 2004, at page 6, first paragraph).

In response, Applicants amended claim 6 to recite a destabilization domain comprising “a ubiquitin homolog [having an] amino acid sequence 85% identical to wild-type ubiquitin.” Applicants submit that this limitation clearly modifies the recitation of the “destabilization domain ... [that] is non-cleavable by α -NH-ubiquitin protein endoproteases” as set forth in claim 1 (see part a), subpart i) of claim 1). Since claim 6 incorporates the limitations of the claim from which it depends (i.e., claim 1), then the destabilization domain of claim 6 is limited to a domain that 1) is non-cleavable by α -NH-ubiquitin protein endoproteases (functional) and 2) comprises a ubiquitin homolog that is at least 85% identical to wild-type ubiquitin (structural). The first limitation is clearly functional while the second limitation is clearly structural and provides the “structure-function” relationship allegedly missing from the amended claim.

While Applicants have proposed amending claim 6 to include a structural limitation, Applicants wish to note that there is nothing inherently wrong with defining some part of an invention by what it does, rather than by what it is (e.g., a destabilization domain that is non-cleavable by α -NH-ubiquitin protein endoproteases). The courts have repeatedly held that functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 (1971); MPEP §2173.05(g). Thus, the limitation used to define the destabilization domain in claim 1 as “non-cleavable by α -NH-ubiquitin protein endoproteases” (see claim 1, part a), subpart i)) is perfectly acceptable because it sets definite boundaries on the patent protection sought.

The specification provides support for ubiquitin homologs having a particular mutation that prevents cleavage of the destabilization domain by α -NH-ubiquitin protein endoproteases (see e.g., page 13, lines 9-19). However, the law does not require the Applicants to “structurally” identify each and every ubiquitin homolog in the claims or even in the specification. Accordingly, Applicants respectfully request clarification from the Examiner as to why the proposed amendment to claim 6 requires further search and/or consideration by the Examiner when the proposed amendment merely defines the destabilization domain as comprising “a ubiquitin homolog ... [having] at least 85% identical to the amino acid sequence of wild-type ubiquitin.” In the absence of such clarification, Applicants submit that the

proposed amendment to claim 6 does not require additional search or consideration and requests that the Examiner enter the amendment.

The Office action further states that the proposed amendment to claim 1, which changes “decreasing” the stability of the reporter moiety to “increasing,” raises new issues that require additional consideration and/or further search. Applicants respectfully point out that the amendment to claim 1 was proposed by Applicants in response to the following statement by the Examiner:

“It is noted that the specification indicates that the destabilization domain destabilizes the receptor moiety when the destabilization domain is coupled to the reporter. Since cleavage of the linker moiety with a protease would disassociate the destabilization domain from the moiety domain, the result would not be a decrease in the stability of the reporter moiety, but rather an increase in the reporter moiety” (see Final Office Action dated August 13, 2004, at page 3, last paragraph, bridging to page 4, line 1).

In the reply dated December 13, 2005, Applicants proposed replacing the term “decreasing” with the term “increasing” in claim 1 because the specification, as noted by the Examiner, supports the amendment. The Examiner clearly understands that the amendment is consistent with specification and with the scientific principles associated with reporter moiety stability, yet the Examiner has taken the position that further search and/or consideration is necessary in view of the amendment. Applicants invite the Examiner to clarify this position in view of the above discussion. In the absence of such clarification, Applicants submit that the proposed amendment to claim 1 does not require additional search or consideration and requests that the Examiner enter the amendment.

In view of the above discussion, and in light of the response to the final office action, Applicants request that the proposed amendments to the claims be entered. Upon entry of the amendments, Applicants further request that the pending rejections be withdrawn and the application passed to allowance. Absent withdrawal of the rejections and allowance of the claims, Applicants request withdrawal of the finality of the pending final rejection. In the

event the Examiner maintains the positions stated in the pending Advisory Action, Applicants respectfully request an interview with the Examiner and his Supervisor so that the issues raised above can be discussed.

Objections

Claim 60 is objected to for reciting "a" instead of "α." Claim 60 has been amended to recite "α." Applicants request withdrawal of the objection.

Rejections under 35 U.S.C. § 112, First Paragraph

Enablement

Claims 1-9 and 11-22 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make or use the invention. Specifically, the Examiner alleges that "decreasing" the stability of the reporter moiety, as recited in claim 1, is not enabled by the specification. While Applicants traverse this rejection, it is noted that claim 1 has been amended to recite "increasing" the stability of the reporter moiety. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are requested.

The Examiner further alleges that without a clear description of the ubiquitin "homologs" encompassed by the claims, one of skill in the art would not know how to make or use the claimed invention without performing additional experimentation. Applicants traverse this rejection and submit that definition of "homolog" provided at pages 13-14 of the specification and the discussion regarding destabilization domains and the functionality thereof is sufficient to satisfy the Written Description and Enablement requirements of 35 U.S.C. § 112, first paragraph.

Nevertheless, Applicants note that claims 6, 31 and 38 have been amended to recite a ubiquitin homolog having an amino acid sequence at least 85% identical to the amino acid

sequence of wild-type ubiquitin. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are requested.

Written Description

Claims 1-9, 11-38, 40 and 80-87 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants traverse the rejection.

Applicants maintain that the definition of "homolog" provided at pages 13-14 of the specification and the discussion regarding destabilization domains and the functionality thereof is sufficient to satisfy the Written Description and Enablement requirements of 35 U.S.C. § 112, first paragraph. However, in order to expedite allowance of the pending claims, Applicants have amended claims 6, 31 and 38 to recite a ubiquitin homolog having an amino acid sequence at least 85% identical to the amino acid sequence of wild-type ubiquitin. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, are requested.

In re Application of:
Stack et al.
Application No.: 09/498,098
Filed: February 4, 2000
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Attorney Docket No.: VERT1330 (FORMERLY AURO1330)

CONCLUSION

In view of the amendments and the above remarks, it is submitted that the claims are in condition for allowance and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to this application.

Applicants have enclosed a check number 574560 in the amount of \$1,520.00 for the additional three-month extension fee associated with this submission. Applicants do not believe any other fees are due in connection with this submission, however if any other fees are due, please charge any fees, or make any credits, to Deposit Account No. 07-1896.

Respectfully submitted,

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